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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/941,151

08/28/2001

Eric Chapoulaud

ORM-156CO

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EXAMINER

EIDE, HEIDI MARIE

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

06/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/941,151	<b>Applicant(s)</b> CHAPOULAUD ET AL.	
	<b>Examiner</b> HEIDI M. EIDE	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 120-132 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 120-132 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 21, 2009 has been entered.

### ***Claim Objections***

Claim 124 is objected to because of the following informalities: It is believe that "threedimensional" in line 5 of the claim is in error for --three-dimensional--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 120-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al. (5,975,893) in view of Lehmann et al. (6,575,751). Chishti et al. discloses a method of providing a custom orthodontic appliance for repositioning teeth of a patient comprising providing for display on a computer screen, with interaction by an operator

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(user), data of images of the teeth of the patient in suggested post-treatment tooth positions and orientations (final digital data set) based on three-dimensional information of the shapes of the teeth (column 5 line 37), receiving feedback information from a person (treating professional), other than the operator, and providing a custom orthodontic appliance configured to reposition teeth based on the suggested post treatment tooth positions and orientations. It is noted that the interactive step is written in the past tense, and interactivity can be interpreted as with the computer system. Furthermore, there is suggestion as to various times when "users" can provide feedback as in information to modify (change) or accept (not change) tooth positions and orientations in obtaining post-treatment tooth positions and orientations (columns 4-7, 9-14). However, Lehmann et al. is used to teach a situation in which the person, treating professional, or orthodontic practitioner (dentist) does not have access to the computerized site and uses the services of another such as that of the operator, user, or laboratory, and interactivity is present in the method of providing a custom dental appliance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the person who has interactively viewed a display of the images as understood as in Lehmann et al. in order to enable the person to save time and effort in communicating with the laboratory operator in view of Lehmann et al. As changes are incorporated, it is redisplayed.

3. Claims 120-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chishti et al. (5,975,893) (Chishti) in view of Hultgren 6,217,334 further in view of Peltz 6,205,716. Chishti teaches a method of providing a custom orthodontic appliance for

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repositioning teeth of a patient comprising providing for display on a computer screen (col. 5, ll. 49-51) with interaction by an operator (user), data of images of the teeth of the patient in suggested post-treatment tooth positions and orientations (final digital data set) based on three-dimensional information of the shapes of the teeth (col. 5 ll. 49-64), receiving feedback information from a treating professional providing revised images of the teeth (col. 14, ll. 24-34 and providing custom appliances based of the feedback (fig. 7, col. 14, ll. 35-37). The feedback received from the treating professional, such as approval or suggestions would have been obvious information to provide during an orthodontic consultation. Chishti does not specifically state if the person who delivered the feedback is different from the operator. Hultgren teaches digitizing tooth models, creating a positive image and producing them by remote transmission to a consulting dentist (col. 7, ll. 40-56). The step of providing by remote transmission obviously teaches that the operator doing the scanning is a different person than the dentist, as such, it would have been obvious to one having ordinary skill in the art to modify Chishti in view of Hultgren to include the operator and an orthodontist of being different people as shown by Hultgren in order to provide more accurate digital images at a remote lab. Chishti in view of Hultgren does not specifically teach the interaction with the operator and receiving the feedback is interactive. Peltz teaches an interaction communication between a user and a medical professional (abstract, col. 1, ll. 34-43, 47-50, col. 2, ll. 5-10, col. 7, ll. 52-60). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Chishti in view of Hultgren to include an interaction

between the treating professional and the user in order to receive immediate feedback from a specialist.

***Response to Amendment***

The affidavit filed on April 21, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Lehmann reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Lehmann reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence submitted does not support the limitation of receiving feedback information on the treatment position from a person other than the operator. The applicant has submitted Exhibits U and V in which they claim shows support for this limitation, however, these documents do not show evidence of feedback being provided. Since it was not specifically stated, it is assumed that the evidence is attempting to establish actual reduction to practice before the reference date.

***Response to Arguments***

Applicant's arguments filed April 21, 2009 have been fully considered but they are not persuasive. See above statement regarding the affidavit.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEIDI M. EIDE whose telephone number is (571)270-3081. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Heidi Eide  
Examiner  
Art Unit 3732**

**/John J Wilson/  
Primary Examiner  
Art Unit 3732**

/Heidi M Eide/  
Examiner, Art Unit 3732

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